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In re Application	:
Reche-Gallardo, et al.	:
Application No. 10/008,566	: DECISION ON APPLICATION
Filed: February 8, 2001	: FOR PATENT TERM ADJUSTMENT
Atty Docket No. DX01341	:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 C.F.R. 1.705)(b)," filed August 24, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from three hundred forty-four (344) days to four hundred twenty-one (421) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein. However, Applicants' request that an additional PTO delay of twenty-two (22) days be assessed is being **HELD IN ABEYANCE** until after the actual patent date.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is **three hundred ninety-nine (399) days**. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On May 25, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is three hundred forty-four (344) days. On August 24, 2004, Applicants timely¹ submitted an application for patent term adjustment, asserting that the correct number of days of PTA at the time of the mailing of the Notice of Allowance is four hundred twenty-one (421) days.

Applicants assert entitlement to a patent term adjustment of four hundred twenty-one (421) days on the basis that the PTO improperly assessed Applicants a delay of thirty-six (36) days for responding to a Notice to File Missing Parts mailed on January 29, 2002. Applicants assert that they filed a response on May 8, 2002, and pursuant to 37 C.F.R. §1.704(b), should have been assessed applicant delay of nine (9) days, not thirty-six (36) days.

In addition, Applicants assert that the PTO improperly assessed applicant delay of twenty-eight (28) days for a supplemental reply filed on April 19, 2004. Applicants originally had filed an Amendment to a February 20, 2004 Office action on March 22, 2004. Applicants assert that the Supplemental Amendment was filed in response to a telephone interview with the Examiner.

Lastly, Applicants assert additional PTO delay of twenty-two (22) days for the failure on the part of the Office to issue the patent within three years of its filing. The Office will be able to assess whether or not any additional PTA is accorded once the issue date is established.²

Applicants state that the patent issuing from the application is not subject to a terminal disclaimer.

The Office initially determined a patent term adjustment of three hundred forty-four (344) days based on an adjustment for PTO delay of five hundred eight (408) days pursuant to 35 U.S.C. 154(b)(1)(A)(i) and 37 C.F.R. §1.703(a)(1), reduced by

¹ Applicants filed the PTA prior to filing the issue fee.

² Applicant should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

Applicants' delay of thirty-six (36) days pursuant to 35 U.S.C. 154(b)(1)(C)(ii) and 37 C.F.R. §1.704(b), and twenty-eight (28) days pursuant to 35 U.S.C. 154(b)(2)(C)(iii) and 37 C.F.R. §1.704(c)(8). The PTO delay of 408 days has been reviewed and found to be correct. The adjustments of 36 and 28 days are at issue.

The adjustment of 36 days has been found to be incorrect. A review of the application file reveals that a Notice to File Missing Parts of Nonprovisional Application was mailed on January 29, 2002. Applicants timely filed a complete response to this notice on May 8, 2002. Accordingly, pursuant to 37 C.F.R. §1.704(b), nine (9) days of applicant delay should have been assessed, not 36 days.

The adjustment of 28 days has also been found to be incorrect. A review of the application file reveals an interview summary, in which the Examiner indicated what Applicants needed to do to place the claims in condition for allowance. In view thereof, it is concluded that the Supplemental Amendment was "expressly requested by the examiner" as set forth in 37 C.F.R. §1.704(c)(8), and as such, no applicant delay should have been assessed.

Lastly, Applicants assert that additional PTO delay of twenty-two (22) days for the failure on the part of the Office to issue the patent within three years of its filing. The Office will be able to assess whether or not any additional PTA is accorded once the issue date is established.³

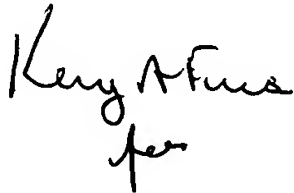
In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **three hundred ninety-nine (399) days** (408 days of PTO delay, reduced by 9 days of applicant delay).

The \$200.00 fee set forth in 37 C.F.R. § 1.18(e) has been charged to Deposit Account No. 04-1239, as authorized.

³ Applicants should note that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period of pendency before the Office except for periods excluded under 35 U.S.C. (b)(1)(B)(i)-(iii), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A).

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

A handwritten signature in cursive script, appearing to read "Karin Ferriter".

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of Revised PAIR Screen